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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,498	12/17/2001	William Milam JR.	MILAM-003	4286
7590	12/15/2004		EXAMINER	
Jack I J'maev 12616 Lewis Ave Chino, CA 91710			YODER III, CHRISS S	
			ART UNIT	PAPER NUMBER
			2612	
DATE MAILED: 12/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,498

Applicant(s)

MILAM ET AL.

Examiner

Chriss S. Yoder, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 7, 8, and 13-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, and 9-11 of copending Application No. 10/023494. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons discussed below.

Claims 1 and 7 are more broad in scope than claim 1 of application 10/023498, therefore, and patent granted on it would result in the unjustifiable timewise extension of the monopoly eventually granted on claim 1 of application 10/023498. Additionally, it is important that these two inventions are always commonly owned.

Claim 2 is verbatim the same as claim 2 of 10/023494.

Claim 8 is verbatim the same as claim 2 of 10/023494.

Claim 13 is more broad in scope than claim 9 of application 10/023498, therefore, and patent granted on it would result in the unjustifiable timewise extension of

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the monopoly eventually granted on claim 9 of application 10/023498. Additionally, it is important that these two inventions are always commonly owned.

Claim 14 is verbatim the same as claim 10 of 10/023494.

Claim 15 is verbatim the same as claim 11 of 10/023494.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

The disclosure is objected to because of the following informalities:

Page 16, line 10 recites the limitation "camera 40 relative to the optical path length" in line 6 of claim 5, which the examiner believes should read "camera 40 relative to the optical path length"

Appropriate correction is required.

Claim Objections

Claim 5 is objected to because of the following informalities:

Claim 5 recites the limitation "physical interference of the eyepiece with the *camera*" in line 6 of claim 5, which the examiner believes should read "physical interference of the eyepiece with the *camera*." This claim will be examined as understood by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

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subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3, 5-7 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US Patent # 6,147,797).
2. In regard to claim 1, note Lee discloses the use of an imaging instrument comprising an optical path wherein the optical path comprises a first subject matter starting point and an original image plane ending point (figure 1: microscope 5 is considered to be the imaging instrument), attaching a quick-release receptacle to the imaging instrument (column 7, lines 17-19; and figure 6: 280 is attached to the microscope; as for the quick release feature, this can be seen in figures 11-14: as ring 340 is turned, the arms 303 are moved toward the center in order to tighten onto microscope feature 310), affixing a replacement camera comprising a replacement image plane and a lens mount to a camera adapter coupling (the camera captures the image on the image plane; and figure 6: the camera 210 has a lens mount 214 where the adapter 220-240 is attached to the camera) wherein the camera adapter coupling comprises a coupling end and a lens emulating flange opposing the coupling end (figure 6: the adapter has a lens emulating flange 224, this lens emulating end connects to the camera in order to emulate the camera lens; and is opposite the coupling end 284-295) and wherein the camera is affixed to the camera adapter coupling by mating the lens emulating flange with the lens mount (figure 6: lens emulating flange 224 is attached to

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lens mount 214), and mating the coupling end of the camera adapter coupling to the receptacle (column 7, lines 17-19).

Therefore, it can be seen that the Lee device fails to disclose the removal of an original camera attachment means from the imaging instrument. Although not explicitly stated, it would have been obvious that the removal of the original camera attachment means from the optical assemblage is necessary in order for the upgrade to be attached to the assemblage (as stated by Lee in column 1, lines 15-63 and column 2, lines 20-23; the camera adapter can be attached/detached). Therefore, it would have been obvious to one of ordinary skill in the art to modify the Lee device to include the removal of the original camera attachment means from the optical assemblage of an imaging instrument in order to allow the upgrade of the attachment means for a new camera.

3. In regard to claim 2, note Lee discloses that the camera is a digital camera (column 5, line 40; 210 is a digital camera).

4. In regard to claim 3, note Lee discloses the insertion of a compensating lens into the optical path of the imaging instrument if a compensating lens is required to focus an image onto the replacement image plane or if enlargement of a subject matter image striking the replacement image plane is desired (column 4, lines 27-37; and figure 5: 80). Lee teaches that this is preferred if the camera has a lens that is not removable in order to compensate for spherical aberration and a chromatic aberration caused by the lenses of the digital camera (column 1, lines 50-55).

5. In regard to claim 5, note Lee discloses that the imaging instrument comprises an eyepiece (figure 2: 40). Therefore, it can be seen that the Lee reference fails to

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disclose the step of displacing the eyepiece. Official notice is taken that the displacement of the eyepiece in a microscope is notoriously well known and expected in the art. Therefore, it would have been obvious to one of ordinary skill in the art to modify the Lee device to allow the user to displace the eyepieces in order to adjust the interpupillary distance so that it may be operated by any user.

As for the limitation that the eyepiece is displaced in order to preclude physical interference of the eyepiece with the camera. This is merely an intended use and therefore holds no patentable weight. Therefore, the displacement of the eyepiece to adjust the interpupillary distance is functionally equivalent.

6. In regard to claim 6, note Lee discloses that the imaging instrument comprises an eyepiece (figure 2: 40). Therefore, it can be seen that the Lee reference fails to disclose the step of displacing the eyepiece. Official notice is taken that the displacement of the eyepiece in a microscope is notoriously well known and expected in the art. Therefore, it would have been obvious to one of ordinary skill in the art to modify the Lee device to allow the user to displace the eyepieces in order to adjust the interpupillary distance so that it may be operated by any user.

As for the limitation that the eyepiece is displaced in order compensate for variation in the optical path resulting from displacement of the replacement image plane relative to the original image plane. This is merely an intended use and therefore holds no patentable weight. Therefore, the displacement of the eyepiece to adjust the interpupillary distance is functionally equivalent.

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7. In regard to claim 7, note Lee discloses that the receptacle comprises an offset-eliminating flange (according to applicant's disclosure, the examiner considers the offset-eliminating flange to be a flange that does not introduce an offset, as can be seen in figure 6b and page 14, lines 15-21) and a capture cowling (figure 10: 204 is considered to be the offset-eliminating flange because it does not create an offset, and 280 is considered to be the capturing cowl).

8. In regard to claims 9-13 and 15-16, these are apparatus claims, corresponding to the method of claims 1-3 and 5-6. Therefore, claims 9-13 and 15-16 have been analyzed and rejected as previously discussed with respect claims 1-3 and 5-6.

9. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US Patent # 6,147,797) in view of Feinbloom (US Patent # 4,413,278).

10. In regard to claim 4, note Lee discloses a method of upgrading an imaging system as claimed in claim 1. Therefore, it can be seen that the Lee reference fails to disclose that the length of the camera adapter coupling is adjusted to displace the replacement image plane relative to the original image plane in order to enlarge a subject matter image striking the replacement image plane relative to that same image striking the original image plane. Feinbloom discloses the use of a camera with an adapter to connect an imaging instrument (figure 1: 10, 13, and 20) as well as the adjusting of the length of the adapter (figure 5a-5c). Feinbloom teaches that by adjusting the length of the adapter it can adjust the focus so that it can be used on various devices that may have different focal lengths (column 1, lines 31-36 and column 4, lines 16-36). Therefore, it would have been obvious to one of ordinary skill in the art

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to modify the Lee device to include an adjustable adapter in order focus the device when using different imaging instruments as suggested by Feinbloom.

11. In regard to claim 14, this is an apparatus claim, corresponding to the method of claim 4. Therefore, claim 14 have been analyzed and rejected as previously discussed with respect claim 4.

12. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (US Patent # 6,147,797) in view of Applicant's admitted prior art.

13. In regard to claim 8, note Lee discloses that the receptacle has a flange and a capture cowling (figure 10: 204 is considered to be the flange and 280 is considered to be the capturing cowl). Therefore, it can be seen that the Lee device lacks the use of a non-offset eliminating flange. However, based on the Applicant's admission of prior art in the specification, the use of a non-offset eliminating flange (considered an offset flange according to applicant's figure 6a) to be notoriously well known and expected in the art (page 14, lines 15-21). Therefore, it would have been obvious to one of ordinary skill in the art to modify the primary device to include the use of a non-offset eliminating flange in order to capture parametric data as suggested by Applicant.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US004303322: note the use of interchangeable viewfinders.

US003940777: note the use of quick release lens system.

US003559542: note the use of quick release lens system.

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US004264167: note the use of an adapter that attaches to a camera and a imaging assemblage.

US005373320A: note the use of lenses switched into the optical path in order to correct the image.

US005751353A: note the use of lenses switched into the optical path in order to correct the image.

US006781630B2: note the use of a microscope with an attached camera.

US0020010048549A1: note the use of a microscope with an attached camera.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chriss S. Yoder, III whose telephone number is (703) 305-0344. The examiner can normally be reached on M-F: 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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CSY

December 3, 2004


WENDY R. GARBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600